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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,142	12/21/2000	Yoichi Yamada	107300	7514

25944 7590 07/20/2004

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EXAMINER

PEUGH, BRIAN R

ART UNIT	PAPER NUMBER
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2187

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/720,142

Applicant(s)

YAMADA, YOICHI

Examiner

Brian R. Peugh

Art Unit

2187

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 3,4,6,11 and 17.Claim(s) rejected: 1,2,5,7-10,12-16 and 18-20.

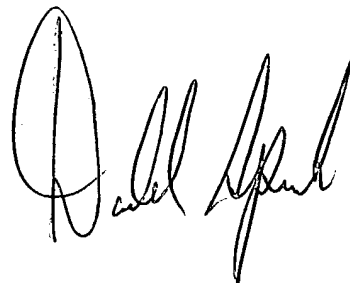
Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

BR Peugh
7/15/04

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Continuation of 5. does NOT place the application in condition for allowance because: Applicant's Request for Reconsideration, filed Jun 14, 2004, has been reviewed by the Examiner and a Special Projects Examiner. Applicant's arguments, and corresponding Affidavits filed January 15, 2004 and May 10, 2004, address that the inventor is not aware of any instance of the art described in the patent application as "conventional" that qualifies as statutory prior art in the United States under 35 U.S.C. 102. The Examiner would like to further clarify why the affidavit is not sufficient to overcome the prior art rejection. The Examiner has not requested prior art of any kind, especially that which would fall under 35 U.S.C. 102. During the interview of December 18, 2003, attended by Applicant's Representative Mr. Woodall and the Examiner, Mr. Woodall and the Examiner discussed that an affidavit with a certified translation from the translator indicating that a translation error had occurred might be sufficient to overcome the prior art rejections. Thus, a request for evidence that the admission of teachings cited as "conventional" was a mistake or mistranslation, that the admission was not prior art, was made. The Affidavit filed January 15, 2004 did not conform to the the content discussed in the interview, whereupon the Examiner brought the Affidavit to the attention of a Special Projects Examiner. The Special Projects Examiner indicated that the affidavit would not be sufficient to overcome the prior art rejection, but an affidavit in accordance with the guidelines discussed in the interview may overcome the prior art rejections, as indicated in Examiner's Final Office Action of February 11, 2004. Applicant's representative submitted an affidavit on May 10, 2004, identical to the affidavit of January 15, 2004, with arguments corresponding to the qualification of prior art under 35 U.S.C. 102. The Examiner's Advisory Action of May 25, 2004, reiterated the Examiner's previous position that the affidavit was insufficient to overcome the prior art rejections. The Examiner also directed Applicant's Representative to MPEP 2129 regarding the admission of prior art. Applicant's arguments of June 14, 2004, include comparisons between the in re Nomiya case and the current application (page 4, section (b)). Applicant's section marked "Background of Art", which contains the "conventional" reference, would correspond to 'Background of the Invention' section as detailed in MPEP 608.01(c). Regarding MPEP 608.01(c), items found under the 'Background of the Art' include "Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information disclosed where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated." Thus, Applicant's admission of a related "conventional" semiconductor would correspond to prior art according to MPEP 608.01(c). Further, regarding Applicant's argument regarding claim 1 on page 9 of the November 12, 2003 response, the Examiner has not not relied upon a single element for two discrete elements. Page four of the Office Action filed February 9, 2004, details the ID-generation circuit for producing production information, as well as the operation of "storing the ID", where the ID is the production information. The Examiner recited that for the ID to be stored, the invention would inherently require a write circuit, or the like, in order to write/store the the production ID. The ID-generation circuit was not recited or relied upon to facilitate the writing/storing of the production information. .



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